

### **Remarks**

Entry of the amendment is respectfully requested. No new matter has been added.

Reconsideration is respectfully requested.

### **Claim Status**

In the Action, claims 8-15 and 17-31 stand objected to as being dependent upon a rejected base claim. The Examiner has indicated that these claims would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The early indication of allowable subject matter is greatly appreciated.

Claim 16 stands rejected under 35 USC § 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Specifically, the Examiner rejected claim 16 as being redundant to claim 15.

Claim 1 stands rejected under 35 USC § 103(a) as being unpatentable over U.S. Patent No. 6,042,001 to Siler et al. (“Siler”).

Claims 2-7 stand rejected under 35 USC § 103(a) as being unpatentable over Siler and further in view of U.S. Patent No. 4,186,977 to Gilovich et al. (“Gilovich”).

### **The Claim Amendments**

Claim 3 has been amended to independent form, incorporating the subject matter of original claims 1 and 2. Arguments for the patentability of claim 3, as amended, are presented below.

The subject matter of original claim 8, deemed allowable, has been incorporated into

newly added independent claim 32. Claims 9-13, 15, and 17-30 each ultimately depend from claim 32 and are thus believed to be allowable.

Claim 14 has been amended to independent form, incorporating the base claim and each intervening claim. The Examiner has indicated the allowability of claim 14, as amended.

Claim 16 has been amended to depend from claim 14, and is thus believed to be allowable.

Claim 29 has been amended to correct a typographical error.

New claim 33 has been added to the subject application. Support for claim 33 is provided in the original specification at page 81, lines 10+; page 82, lines 13+; and page 83, lines 13+, *inter alia*. Claim 33 is believed to be allowable over the cited references due to the features and relationships recited therein. For example, Claim 33 recites a member in operative connection with the lock, wherein movement of the member by a projection in the ATM causes the cover to be held in the closed position when the cover next moves to the closed position.

New claim 34, dependent on claim 2, has been added to the subject application. Support for claim 34 is provided in the original specification at page 78, lines 2-3 and page 83, lines 1-12, *inter alia*. Claim 34 recites an outward extending edge portion adjacent the cover recess. The edge portion is adapted to engage the engaging lever to open the cover as the container is moved into the operative position. Engagement of the engaging lever in the cover recess enables the cover to be closed as the container is moved away from the operative position. None of the cited references teaches or suggests this feature.

New claim 35 has been added to the subject application. Support for claim 35 is provided in the original specification at page 78, lines 19+; page 80 lines 1+; and page 81, lines 1-8; *inter*

*alia.* Claim 35 recites a deposit holding container movably mounted in slidable relationship with inward extending projections of an ATM. When the container is in an operative position, its upper opening is aligned with a deposit envelope opening. A transport is movably mounted with the housing and is movable away from the deposit envelope opening. An interlock mechanism operatively interconnects the container and the transport, wherein when the container is in the operative position, the transport is not movable. None of the cited references teaches or suggests such features and relationships.

New claim 36 has been added to the subject application. Support for claim 36 is provided in the original specification at page 84, lines 6+; page 85, lines 1-14; *inter alia*. Claim 36 recites a movable portion bounding the track, wherein moving the movable portion enables the cover to be removed and replaced. None of the cited references teaches or suggests such features or relationships.

New claims 37 and 38 each depend from claim 36 and recite features previously deemed allowable by the Examiner.

#### 35 U.S.C. § 112 Rejections

Claim 16 has been amended to depend from claim 14, as amended, deemed allowable by the Examiner. Claim 15 depends from claim 13, and ultimately from newly added independent claim 32, which incorporates the subject matter of original claim 8, deemed allowable by the Examiner. Claim 16 is thus not redundant to claim 15. It is respectfully requested that the rejection be withdrawn.

### **35 U.S.C. § 103 Rejections: The Applicable Legal Standards**

The Office has the responsibility to present a *prima facie* case of obviousness under 35 U.S.C. § 103. An Applicant is entitled to a patent if the Office fails to establish a *prima facie* case of obviousness. *In re Oetiker*, 24 U.S.P.Q. 2d 1443 9 (Fed. Cir. 1992). In determining obviousness under 35 U.S.C. § 103, the invention must be considered “as a whole.”

Any modification of the cited reference in order to arrive at Applicant’s invention must be motivated by the cited art. *In re Deminski*, 230 U.S.P.Q. 313 (Fed. Cir. 1986). Applicant’s own disclosure may not serve as a template to piece together the teachings of the prior art to render the claimed invention obvious. *In re Fitch*, 23 U.S.P.Q. 2d 1780 (Fed. Cir. 1992). There must be a reason or suggestion in the prior art for selecting the claimed procedure, other than knowledge learned from Applicant’s disclosure. *In re Dow Chemical*, 5 U.S.P.Q.2d 1529 (Fed. Cir. 1988). Further, the motivation for modifying a reference cannot be found if the reference actually “teaches away” from the claimed invention. *In re Gurley*, 31 U.S.P.Q.2d 130 (Fed. Cir. 1994).

#### **Claim 1**

Claim 1 stands rejected under 35 USC § 103(a) as being unpatentable over Siler. Applicants respectfully traverse the rejection of claim 1. Applicants’ response to the rejection of claim 1 is based on the Examiner’s referenced interpretation of Siler.

The Examiner asserts that Siler includes a chassis member 10, slide channels 32 and runners 30 that read on the Applicants’ body, lip portions and inward extending projections, respectively.

Applicants’ recited features and relationships include “wherein the lip portions are

adapted to slidably engage a pair of disposed inward extending projections ... wherein the container is enabled to be held in suspended *moveable engagement* within the banking machine through the lip portions."

The Examiner's interpretation of Siler fails to provide Applicants' recited features and relationships. For example, according to the teachings of Siler the chassis member 10 "is secured in installed condition against removal." (Col. 4, lines 29-30). The chassis member 10 is secured to a clamping plate 36 by non-reversing screws 38. Thus, the slide channels 32 are not analogous to Applicants' lip portions that enable moveable engagement of the container, when the invention is considered "as a whole."

### Claims 2-7

Claims 2-7 stand rejected under 35 USC § 103(a) as being unpatentable over Siler and further in view of Gilovich.

The admission by the Office that Siler does not teach the features and relationships of claims 2-7 is acknowledged. Applicants respectfully traverse the Examiner's combination of Siler with Gilovich, and further modifications thereof, to support the obviousness rejection of claims 2-7.

### Claim 2

The Examiner's assertions that flexible covers in security containers are well known in the art is not a sufficient basis for the proposed combination. Additionally, the existence of a flexible door 11 in Gilovich does not properly provide the necessary motivation to combine the references. Further, even if the combination is proper, which it is not, such combination requires extensive modification outside the permissible realm, in order to provide Applicants' recited

features and relationships.

Siler teaches “a container-covering lid member 14 which provides a unique multiple function ...” (Col. 3, lines 40-41). One function of the lid member 14 is to securely close the container by engaging the pawl 54 of lock member 52 with a lid recess 56 (Col. 4, lines 57+). Another function of the lid member 14 includes unlocking the container from the chassis member. The lid member 14 includes a projecting tab portion 14' which is adapted to engage the pawl 44 of the lock member 42 thereby disengaging the container from the chassis (Col. 5, lines 9-24). The lid member as taught in Siler must be sufficiently rigid to transfer a force in order to unlock the container from the chassis member. Further, Siler teaches removal of the lid member away from the container (Col. 3, lines 60-64).

Where does the reference teach or suggest replacing a removable, force-imparting rigid lid member with a flexible member? There is no such teaching or suggestion. Only Applicants' specification provides a flexible tambour door 436 including a generally rigid end portion 438 (See page 77, lines 21-22; Figs. 58-59). It is impermissible for the Examiner to use Applicants' own specification as a template to provide the necessary motivation.

Further, a combination of the lid 11 as taught in Gilovich with the container of Siler destroys the teaching of the reference. According to Siler, the leading edge 48 of the lid member 14 must be able to engage the lid lock member 52 as well as the container lock member 42, both of which are situated at an internal location when the container is operatively positioned in the chassis member (See Figs. 7, 9, 10). The lid member 11 of Gilovich slides downward and inward at the innermost side. (See Figs. 1-3). How can an inner edge of the lid member 11 provide the necessary functions as taught by Siler? It cannot; thus the teaching of the reference is

destroyed, and the proposed combination is legally impermissible.

Further, there is no teaching or suggestion in Gilovich that the door 11 may be arranged so as to *reverse* its direction of travel. According to the teachings of Siler: “Collection personnel gain access to the interior of the ATM ... and simply insert the lid panel 14 into its slot in the top frame of the container, *pushing the panel all the way in*. Just prior to full insertion of the lid panel, the pawl 44 (*sic*; should be 54) of the lid panel-locking member 42 (*sic*; should be 52) operatively engages the lid panel and prevents its removal. The container, now closed by the locked lid member, is at this point still locked in place on the chassis member. The collection personnel may then press the lid panel *inward slightly more* whereby the confronting edge of the projecting tab portion 14' of the lid panel member is moved operatively into overriding engagement with the pawl 44, moving the pawl out of engagement with the catch 46 on the chassis member and thereby unlocking the container from the chassis member. The collection personnel then simply *pulls* the container member out of the ATM. When the filled container is removed from the ATM machine, it is replaced with an empty container which . . . had its lid member unlocked and *removed*. The empty, open container member is simply slid onto the chassis member . . . until it locks into place by engagement of the pawl 44 of the lock member 42 on the chassis member with the catch 46 on the container.” ( Col. 5, lines 38+, emphasis added).

The direction of travel of door 11, as taught by Gilovich, is opposite the direction of travel of lid member 14 of Siler. In Siler, the movement of the lid member is directly related to securely closing the container and *unlocking* it from the housing. In Gilovich, the movement of the door 11 is directly tied to the function of locking the depository within housing 14 via the barrier arm 18, which engages the *front wall* of the depository. Thus, there is no motivation to

reverse the direction of travel of door 11. The Examiner's proposed combination and further modifications extend beyond what is legally permissible. It is requested that the rejection of claim 2 be withdrawn.

Claim 3

Claim 3 has been amended to independent form including all the features of originally filed claims 1 and 2. Applicants' remarks in support of the patentability of previously discussed claims are incorporated herein by reference. For reasons previously discussed, the Examiner's proposed combination, and further modification, of the references does not provide the recited features and relationships.

In addition, Siler clearly teaches that the cover is removed from its slot in the top frame of the container. In order to prevent the lid member from being lost or separated, the reference teaches a tether on the *outside* of the container. The reference does not provide any teaching or motivation of storing the lid within the storage container itself. Such a modification would destroy the teachings of the reference, because a lid stored within the container of Siler would require access to the interior of an installed container before the container is unlocked. (The lid member unlocks the container). The reference teaches that the container may be unlocked only after the lid member is securely in place to cover the container opening.

The Examiner's reliance upon Gilovich to provide such teaching is not permissible. As presented above, there is no teaching or suggestion in Gilovich that the closing movement of the lid be reversed. In Gilovich, when the depository is operatively positioned, the door components move inwardly to be stored as the door uncovers the opening (See Figs.). Such movement destroys the teaching of Siler, where inward movement of the lid member 14 *covers the opening*

and engages lock members 42 and 52. The cited references are not properly combined, and thus cannot render the claim obvious.

Claim 4

The comments directed to claims 1-3 are incorporated herein by reference. Applicants' response to the rejection of claim 4 is based on the Examiner's referenced interpretation of the cited references. The Examiner asserts that chassis member 10 reads on Applicants' body. The Examiner does not propose any structure in either reference corresponding to the recited "wherein the body includes a pair of parallel tracks" in which "cover projections in supporting connection with opposed sides of the flexible cover" are movable "as the cover is moved between the open and closed positions."

It is conceded that the Examiner's corresponding body structure (chassis member 10) includes guide track mounting channels 22. However, according to the teachings of the reference, the container, not the lid member, is supported by the guide track mounting channels 22 (Col. 3, lines 40-53). The reference does not teach "cover projections" on "opposed sides of the flexible cover" movable within parallel tracks "as the cover is moved between the open and closed positions." The deficient features are not found in Gilovich.

A rejection under § 103 must consider the invention as a whole. Because recited features and relationships are absent from the teachings of the cited references, the claim cannot be considered as obvious.

Claims 5-7

The comments in support of the patentability of claims 1-4 are incorporated herein by reference. Because the references may not be properly combined, the additional features and

relationships recited in claims 5-7 can not be considered as obvious in view of the references.

Applicants have shown that the features and relationships of the rejected claims are not obvious in view of the cited references. First, the proposed combination of references is not proper as there is no teaching or motivation for the combination in the references themselves, the Examiner may not use Applicants' disclosure as a template for hindsight reconstruction, and the proposed combination would destroy the teachings of one or both of the references. In addition, even if proper, the proposed combination fails to provide the features and relationships recited in the rejected claims. Thus it is requested that the rejections of claims 1-7 under 35 USC § 103 be withdrawn.

**Claim Fees**

Please charge fees for four additional independent claims (in excess of three) at \$200 each, and fees for seven additional claims at \$50 each for a total of \$1,150 to Deposit Account No. 09-0428 (Interbold).

### Conclusion

Each of Applicants' claims have been shown to be allowable over the cited references.

Thus it is believed that the application is in condition for allowance. The undersigned will be happy to discuss any aspect of the Application by telephone at the Office's convenience.

Respectfully submitted,



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